

Docket N : 3043R**Serial No. 09/727,622****REMARKS**

Claims 1, 3-9 and 13-41 are pending in the application. No claims are amended herein.

For the reasons which follow, Applicants respectfully request entry of the present After-Final Reply, reconsideration of the application, withdrawal of the asserted rejections, and allowance of the claims.

Rejection of Claims 1, 3-9 and 13-41 under 35 U.S.C. § 103(a)

Claims 1, 3-9 and 13-41 stand rejected as obvious over Schechter, U.S. Patent No. 5,456,222 in view of Manka et al., U.S. Patent No. 5,834,407.

Applicants traverse the obviousness rejections of claims 1, 3-9 and 13-41 for at least the following reasons, as well as the reasons set forth in the Amendment filed October 13 2003, which is incorporated herein by reference.

In the present final Office Action, the Examiner reiterated the previously asserted rejection of Applicants' claims, contending that "It would have been an obvious matter of design choice to use the low-phosphorus lubricating oil composition on the camless engine to reduce wear and exhaust gas emissions because of the low amount of phosphorus." This is a substantially similar statement of the Examiner's position in the Office Action mailed July 14, 2003.

In response to the rejection set forth in the Office Action mailed July 14, 2003, Applicants set forth an extensive argument showing that the Examiner had failed to state a prima facie case of obviousness, based on the disclosures of the cited references and the Examiner's failure to adequately show either of any motivation for, or any reasonable expectation of success in, making the asserted combination of Schechter and Manka et al.

In response to Applicants' arguments, the Examiner provided the following:

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In this case, it would have been obvious to one having ordinary skill in the art at the time the invention was made to employ the low-phosphorus lubricating oil composition in the electro-hydraulic actuator of a camless engine in order to reduce wear, noise and emissions because the low-phosphorus amount in the lubricating oil composition. (sic, emphasis added.)

Applicants respectfully submit that the underlined words fail to provide any factual showing of the requisite motivation to combine. The words do not even form a complete sentence. The "because" clause lacks a verb. Applicants cannot understand this incomplete statement. If Applicants are to appeal the rejection, there must be a complete, understandable statement of the Examiner's position on the record.

The grammatical errors aside, the Examiner has failed to make the required factual showing to support the obviousness rejection. The Examiner has simply stated in conclusory fashion with no supporting facts that it would have been obvious to make the asserted combination. This conclusory assertion is wholly inadequate to satisfy the legal test required to reject claims for obviousness.

Recently, in an appeal from an examiner's rejection, *In re Lee*, 61 USPQ2d 1430, 1433 (Fed. Cir. 2002), the Federal Circuit reviewed and reiterated the law relating to the required showing of motivation to combine references, stating as follows:

When patentability turns on the question of obviousness, the search for and analysis of the prior art includes evidence relevant to the finding of whether there is a teaching, motivation, or suggestion to select and combine the references relied on as evidence of obviousness. See, e.g., *McGinley v. Franklin Sports, Inc.*, 262 F.3d 1339, 1351-52, 60 USPQ2d 1001, 1008 (Fed. Cir. 2001) ("the central question is whether there is reason to combine [the] references," a question of fact drawing on the *Graham* factors). (Emphasis added.)

"The factual inquiry whether to combine references must be thorough and searching." *Id.* It must be based on objective evidence of record. This precedent has been reinforced in myriad decisions, and

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cannot be dispensed with. See, e.g., *Brown & Williamson Tobacco Corp. v. Philip Morris Inc.*, 229 F.3d 1120, 1124-25, 56 USPQ2d 1456, 1459 (Fed. Cir. 2000) (“a showing of a suggestion, teaching, or motivation to combine the prior art references is an ‘essential component of an obviousness holding’”) (quoting *C.R. Bard, Inc., v. M3 Systems, Inc.*, 157 F.3d 1340, 1352, 48 USPQ2d 1225, 1232 (Fed. Cir. 1998)); *In re Dembiczak*, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999) (“Our case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references.”); *In re Dance*, 160 F.3d 1339, 1343, 48 USPQ2d 1635, 1637 (Fed. Cir. 1998) (there must be some motivation, suggestion, or teaching of the desirability of making the specific combination that was made by the applicant); *In re Fine*, 837 F.2d 1071, 1075, 5 USPQ2d 1596, 1600 (Fed. Cir. 1988) (“teachings of references can be combined only if there is some suggestion or incentive to do so.”) (emphasis in original) (quoting *ACS Hosp. Sys., Inc. v. Montefiore Hosp.*, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984)). (Emphasis added.)

The need for specificity pervades this authority. See, e.g., *In re Kotzab*, 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000) (“particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed”). (Emphasis added.)

In the present case, the Examiner failed to adequately provide the required factual support for a motivation to make both the selection from and the combination of disclosures from the Schechter and Manka et al. references, as contended by the Examiner to render obvious that which Applicants have described and claimed. The examiner's conclusory statement “to reduce wear, noise and emissions because the low-phosphorus amount in the lubricating oil composition” not only does not make grammatical sense, it is exactly the conclusory contention wholly lacking in a factual evidentiary basis in the record referred to and found inadequate to support obviousness rejections by the Federal Circuit in the above-quoted cases.

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It is improper, in determining whether a person of ordinary skill would have been led to an asserted combination of references, simply to "[use] that which the inventor taught against its teacher." *W.L. Gore v. Garlock, Inc.*, 220 USPQ 303, 312-13 (Fed. Cir. 1983). Thus, the Examiner must not only make the requisite findings, based on evidence of record, but must also explain the reasoning by which the findings are deemed to support the Examiner's conclusion of obviousness. The wholly conclusory statements presently of record in the present application fail to provide either findings or reasoning. Therefore, the Examiner has failed to state a *prima facie* case of obviousness with respect to the presently pending claims.

Omission of a relevant factual showing required by precedent is legal error. Since the Examiner failed to show the obviousness of Applicants' claimed invention in accordance with the law, Applicants are entitled to have the claims allowed and a patent to issue from the present application.

For the foregoing reasons, Applicants respectfully submit that the invention claimed in claims 1, 3-9 and 13-41 would not have been obvious over Schechter in view of Manka et al. Applicants respectfully request the Examiner to withdraw the rejection of these claims, and to indicate the allowability thereof.

CONCLUSION

For the foregoing reasons, Applicants respectfully submit that all of the presently pending claims patentably distinguish over the prior art generally, and over Schechter in view of Manka et al. in particular, and that all of Applicants' claims are therefore in condition for allowance. Applicants request the Examiner to so indicate.

If the Examiner considers that a telephone interview would be helpful to facilitate favorable prosecution of this application, the Examiner is invited to telephone the undersigned.

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No additional fees are believed due for the filing of this paper. However, if a fee is required, please charge the fee to Deposit Account No. 18-0988, Order No. 3043R.

Respectfully submitted,

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